

Via Facsimile, May 27, 2005  
 Commissioner for Patents  
 App. No. 09/760,063  
 Page 10 of 14

## REMARKS

Claims 1-36 were pending in this application as of the Examiner's Office Action to which this Amendment is responsive. Claims 1-36 are rejected.

The below remarks are organized according to the section headings of the Examiner's Detailed Action of Nov. 29, 2004.

### Table of Contents to Remarks

1. Section I.....	10
1.1. Appendices.....	10
1.2. Information Disclosure Statement .....	11
1.3. Claim Rejections - 35 U.S.C. § 101.....	11
1.4. Claim Rejections - 35 U.S.C. § 102.....	11
1.5. Claim Rejections - 35 U.S.C. § 103.....	12
2. Section II.....	13
2.1. Claim Rejections - 35 U.S.C. § 101.....	13
2.2. Claim Rejections - 35 U.S.C. § 102.....	13
2.3. Claim Rejections - 35 U.S.C. § 103.....	13
3. Summary.....	13

## 1. Section I

### 1.1. Appendices

The Examiner has required Appendices 1 and 2 be submitted on compact disc on the basis that each contains over 300 lines of computer program listing and cites to 37 CFR 1.96(c).

Upon careful examination of Appendix 1, however, applicants respectfully submit that it does not contain a "computer program listing" as defined by 37 CFR 1.96(a). Furthermore, even if Appendix 1 did contain a computer program listing, it would be not be subject to 37 CFR 1.96(c) since it does not contain over 300 lines of computer program listing.

The portions of Appendix 1, to which 37 CFR 1.96(c) might possibly apply, are at the following locations: page 26, pages 28-30, pages 45-46, page 47 and page 48. At all of these locations, Appendix 1 states that the listing is of pseudocode.

Pseudocode is so-called precisely because it is not executable by a computer. 37 CFR 1.96(a), however, states that a computer program listing is "a program for a computer." Pseudocode, in contrast, is a form of exposition, written to explain concepts and techniques to people. 37 CFR 1.96(a) further states that a computer program listing must be written in a "language which will cause a computer to perform a desired

Via Facsimile, May 27, 2005  
Commissioner for Patents  
App. No. 09/760,063  
Page 11 of 14

procedure or task." Pseudocode, by its very nature, is written in a language that does cause a computer to take action.

Furthermore, applicants have counted the number of lines of pseudocode, on the above-listed pages, and find the total to be 217.

Applicants have decided to delete Appendix 2 as being unnecessary. Therefore, the Examiner's requirement, that the computer program listing portions of Appendix 2 be moved to a compact disc, is rendered moot.

#### 1.2. Information Disclosure Statement

Applicants decline to submit the specification references, referred to by the Examiner, in an Information Disclosure Statement and they are not believed to be material to patentability. However, applicants have decided to submit an Information Disclosure Statement with a general background reference on random simulation.

#### 1.3. Claim Rejections - 35 U.S.C. § 101

The Examiner has rejected the claims under § 101 for having "no post-solution or final result."

Applicants have Amended each independent claim (claims 1, 9, 17 and 25) to recite production of a result: "recording an indication that a goal state has been reached, that can be used by a user, if a goal state has been found." Applicants respectfully submit that the Examiner's rejection has been traversed for all independent claims.

Since all independent claims recite production of a result, all dependent claims include the limitation as well and therefore traverse the Examiner's rejection.

#### 1.4. Claim Rejections - 35 U.S.C. § 102

Applicants submit herewith a 37 CFR 1.132 Declaration from each inventor stating unequivocally that:

To the extent Ho et al. discloses an invention or inventions claimed by the above-referenced patent application, Ho et al. is disclosing work that originated only from myself and my co-inventors as named in the above-referenced patent application.

Applicants believe the Declarations are in accordance with MPEP 716.10 ("Attribution") which states:

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship.

\* \* \*

#### EXAMPLES

Via Facsimile, May 27, 2005  
Commissioner for Patents  
App. No. 09/760,063  
Page 12 of 14

The following examples demonstrate the application of an attribution affidavit or declaration.

**Example 1**

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

**Example 2**

Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.

Thus, with the 37 CFR 1.132 Declarations, applicants respectfully submit that Ho et al. cannot be used as a prior art reference.

Since the Examiner has not presented prior art as a basis for the § 102 rejections, applicants respectfully traverse such rejections.

**1.5. Claim Rejections - 35 U.S.C. § 103**

The Examiner's § 103 rejections are based on a combination of the Ho et al. and Harer references.

As discussed above, Ho et al. is not a prior art reference.

Applicants have already addressed the Harer reference in our prior Amendment and note that the Examiner does not address that response in his last Office Action. Applicants therefore respectfully re-submit our arguments, of our last Amendment, that the Harer "reference," cited by the Examiner on a PTO-892 form included with the May 13, 2004 Office Action, is Appendix 1 of the present application of applicants and is not prior art.

Applicants have made no suggestion Appendix 1 is prior art, since Appendix 1 is included in the specification under the section "Brief Description of the Printed Appendices" that immediately follows "Brief Description of the Drawings." Applicants

Via Facsimile, May 27, 2005  
Commissioner for Patents  
App. No. 09/760,063  
Page 13 of 14

believe that Appendix 1 is a company-internal document and is not a publication.

The Examiner seems to be asserting a "publication" date of 02/14/00 for the Harer reference only on the basis of Appendix 1 bearing a date of 02/14/00. However, the Examiner points to no evidence that such date is a publication date.

If the Examiner has a basis for asserting that the Harer reference is prior art, applicants respectfully request the Examiner to specifically state such basis in the next Office Action.

Since the Examiner has not presented prior art as a basis for the § 103 rejections (i.e., neither Ho et al. nor Harer are prior art), applicants respectfully traverse such rejections.

## 2. Section II

### 2.1. Claim Rejections - 35 U.S.C. § 101

The Examiner has rejected the claims under § 101 for not being "tangible."

Applicants have Amended each independent claim (claims 1, 9, 17 and 25) to recite production of a tangible result: "recording an indication that a goal state has been reached, that can be used by a user, if a goal state has been found." Applicants respectfully submit that the Examiner's rejection has been traversed for all independent claims.

Since all independent claims recite production of a result, all dependent claims include the limitation as well and therefore traverse the Examiner's rejection.

### 2.2. Claim Rejections - 35 U.S.C. § 102

As stated above, in section 1.4 of the Remarks, since the Examiner has not presented prior art as a basis for the § 102 rejections, applicants respectfully traverse such rejections.

### 2.3. Claim Rejections - 35 U.S.C. § 103

As stated above, in section 1.5 of the Remarks, since the Examiner has not presented prior art as a basis for the § 103 rejections (i.e., neither Ho et al. nor Harer are prior art), applicants respectfully traverse such rejections.

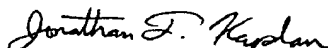
## 3. Summary

Applicants respectfully submit all objections, rejections and requirements have been fully responded to and request a Notice of Allowance.

Via Facsimile, May 27, 2005  
Commissioner for Patents  
App. No. 09/760,063  
Page 14 of 14

The U.S. Patent and Trademark Office is authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 502584 referencing docket number 06816.0173.

Respectfully submitted,



Jonathan T. Kaplan  
Registration No. 38,935

Date: May 27, 2005  
JONATHAN T. KAPLAN  
ATTORNEY AT LAW  
140 NASSAU STREET  
NEW YORK, NY 10038-1501  
TEL. 917-674-5017